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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER	
ALEJANDRO, RAYMOND	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE S. SMOTKIN

Appeal 2009-011268
Application 09/891,200
Technology Center 1700

Decided: April 29, 2010

Before JEFFREY T. SMITH, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests reconsideration of our Decision of January 22, 2010 ("Decision"), wherein we sustained the Examiner's rejection of claims 75, 76, 80, 81, 84, 85, 89, and 90 under 35 U.S.C. § 102(b) as anticipated by Baucke (US 5,094,927, issued Mar. 10, 1992), as well as the Examiner's rejection of these claims, in the alternative, under 35 U.S.C. § 103(a) as

unpatentable over Baucke. (Request for Rehearing ("Req."), filed Feb. 22, 2010.)

Appellant contends the Board's affirmance is based on an erroneous finding that Baucke's layer 14 could function as an electrode. (Req. 2[1]; *see also*, Req. 4, 2nd para.) According to Appellant, because layer 14 is too thin to function as an electrode, the evidence fails to support a finding that Baucke's layers 12 and 13 are inherently capable of functioning as an electrolyte in a fuel cell[2] as required by the appealed claims. (Req. 3[3].)

Appellant admits that the arguments regarding Baucke's layer 14, as well as the evidence now relied upon in support thereof (*see* Req. 2 (referencing Exhibit A)), were not previously presented in the Appeal and Reply Briefs. (*Cf.* Req. 3, last two paras.; *see generally*, App. Br. 9-11 and Rep. Br. 2-4.) However, Appellant contends that prior to our Decision, he was unaware the Examiner's rejection was based on a finding that Baucke's layer 14 corresponds to an electrode and, therefore, did not previously have

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[1] "It appears essential to the finding of inherent anticipation that the arrangement disclosed by Baucke is such that the palladium layer 14 can be construed as itself being an electrode so that the nickel layer 13 can be construed as the claimed support."

[2] (*See* Decision 15-16 ("The Examiner finds that Baucke's nickel layer 13 and electrolyte layer 12 correspond, respectively, to Appellant's claimed support and coating. (*See* Ans. 5-6 and 34.) Baucke's layers 12 and 13 are positioned between two layers 11 and 14 which can be employed as electrodes. (*See* Ans. 6.) The Examiner finds that the structure formed by layers 11-14 is a MEA. (*Id.*) The Examiner thus contends that Baucke's layers 12 and 13 are capable of use as an electrolyte in a fuel cell and, therefore, finds that layers 12 and 13 form a proton-conducting membrane as claimed in claims 75 and 84. (*Id.*)" (footnote omitted)).)

[3] "[I]t is improper to interpret 11 and 14 in Baucke as the electrodes and thus casting layers 12 and 13 inherently in the role of a support with an electronically-insulating protein-conducting coating."

an opportunity to present the arguments and evidence now relied upon in the Request. (*See* Req. 3.)

We understand Appellant's position to be that the Board advanced a new line of reasoning in its Decision which differed from the Examiner's reasoning such that we should have denominated our affirmance a new ground of rejection pursuant to 37 C.F.R. § 41.50(d). In this regard, we note that while 37 C.F.R. § 41.52(a)(1) generally prohibits reliance on new arguments and evidence in a request for rehearing, an appellant may advance new arguments in response to a new ground of rejection made by the Board in its Decision. 37 C.F.R. § 41.52(a)(3).

We have reviewed our Decision in light of Appellant's position. However, we are not persuaded that the facts and reasons identified as relevant to our affirmance differed from those relied upon by the Examiner in rejecting the claims such that Appellant was not previously afforded a fair opportunity to react to the thrust of the rejection. *See In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) ("[T]he ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.").

In finding that Baucke's layers 11 and 14 "can be employed as electrodes," we cited page 6 of the Answer (*see supra* note 2), wherein the Examiner states: "Further exemplified in EXAMPLE is the use of a palladium layer 14 having a thickness of several atoms layers; and a Ni layer having a thickness of 0.5 μm (COL 7, lines 1-8). Specifically disclosed is that palladium . . . can be employed as the electrode material." Thus, the Examiner clearly identified layer 14 as corresponding to one of the electrodes and, upon review of cited disclosure in Baucke (i.e., col. 7, ll. 1-

2), it is apparent that the referenced "Ni layer" corresponding to the other electrode is layer 11.

Because we are not convinced that we erred in failing to denominate our affirmance a new ground of rejection pursuant to 37 C.F.R. § 41.50(d), we decline to consider Appellant's newly presented arguments and evidence in support of patentability of claims 75, 76, 80, 81, 84, 85, 89, and 90.

As indicated above (*see supra* p. 2), Appellant did not previously challenge the Examiner's findings that Baucke's layers 11 and 14 can be employed as electrodes such that layers 12 and 13, positioned therebetween, are properly viewed as capable of use as an electrolyte in a fuel cell. Thus, because the Board did not previously consider any arguments with regard to these findings, Appellant cannot now argue that any inaccuracies in these findings are "points believed to have been misapprehended or overlooked by the Board" in its decision. 37 C.F.R. § 41.52(a)(1). Moreover, because Appellants did not previously argue that the Examiner erred in finding that layers 11 and 14 can be employed as electrodes, it was reasonable for the Board to rely on these factual findings as accurate in affirming the Examiner's finding of anticipation. *See In re Fox*, 471 F.2d 1405, 1407 (CCPA 1973) and *In re Kunzmann*, 326 F.2d 424, 425 n.3 (CCPA 1964) (indicating that an Examiner's statement may be accepted as true when an Appellant fails to question its accuracy or to present contradicting evidence).

In conclusion, based on the foregoing, we have granted Appellant's request to the extent that we have reconsidered our Decision, but we deny Appellant's request to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040